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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,020	08/23/2000	Robert Wallach	4090-4001	2332

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Morgan & Finnegan LLP
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EXAMINER

FRENEL, VANEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 03/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/645,020

Applicant(s)

WALLACH ET AL.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed August 2000.

Claims 1-20 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basic of this rejection is set forth in a two-prong test of :

- (1) whether the invention is within the technology arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. More ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. Looking at the claims 1-20 as a whole, nothing in the body of the claims recite any structure of functionality to suggest that a computer performs the recited steps. Examiner respectfully requests a common

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usage of terms such as "a computer readable-medium" or a "computer system" are well taken to be within the statutory categories within 35 U.S.C. 101 and therefore recommends using such terminologies.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (6,347,302) in view of Borghesi et al (5,950,169).

(A) As per claim 1, Joao discloses a method for providing an incentive relating to a sale or lease of an item, comprising:

determining a class of items for which insurance is to be provided with a sale or lease of one of the class of items (Col.1, lines 6-65);

determining a geographic region in which a buyer of one of the class of items must reside to receive the insurance (Col.2, lines 8-57); and

paying an insurance premium for an insurance policy on behalf of the buyer (Col.7, lines 66-67 to Col.8, line 27. Joao does not explicitly disclose the insurance policy covering an item from the class of items after a sale or lease of the item to the buyer residing in the geographic region.

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However, this feature is known in the art, as evidenced by Borghesi. In particular, Borghesi suggests the insurance policy covering an item from the class of items after a sale or lease of the item to the buyer residing in the geographic region (See Borghesi, Col.9, lines 18-67 to Col.10, line 28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(B) As per claim 2, Borghesi discloses the method wherein the item is an automobile of a particular make and a model (Col.9, lines 57-67 to Col.10, line 28).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claim 1, and incorporated herein.

(C) As per claim 3, Borghesi discloses the method wherein the insurance policy covers comprehensive losses relating to the item (Col.10, lines 6-67).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claim 1, and incorporated herein.

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(D) As per claim 4, Borghesi discloses the method wherein the insurance policy covers collision losses relating to the item (Col.9, lines 7-67 to Col.10, line 28).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claim 1, and incorporated herein.

(E) As per claim 5, Borghesi discloses the method wherein the insurance policy is provided without consideration of further characteristics of the buyer (Col.9, lines 7-67).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claim 1, and incorporated herein.

(F) As per claim 6, Borghesi discloses the method wherein the insurance policy covers all users of the item (Col.15, lines 24-67 to Col.16, line 67).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claim 1, and incorporated herein.

(G) As per claim 7, Joao discloses the method wherein the insurance policy remains in effect if the buyer moves from the geographic region (Col.2, lines 19-49).

(H) As per claim 8, Borghesi discloses the method wherein said paying further comprises paying the insurance premium to an affiliate for the insurance policy (Col.2, lines33-67).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claim 1, and incorporated herein.

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(I) As per claim 9, Borghesi discloses the method wherein the insurance premium is the same for each of the class of items sold in the geographic region (Col.4, lines 1-38).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claim 1, and incorporated herein.

(J) As per claim 10, Joao discloses a method for providing an incentive relating to a sale or lease of an item, comprising:

receiving an indication of a class of items for which insurance is to be provided to a buyer residing in a geographic region (Col.1, lines 6-65)

completing a sale or lease of one of the class of items to a particular buyer residing in the geographic region (Col.2, lines 8-57);

confirming that the buyer resides in the geographic region (Col.2, lines 20-67); and providing, in a sales agreement relating to the sale or lease of the item (Col.2, lines 58-67 to Col.3, line 21). Joao does not explicitly disclose a confirmation of a provision of an insurance policy covering a loss relating to the item.

However, this feature is known in the art, as evidenced by Borghesi. In particular, Borghesi suggests a confirmation of a provision of an insurance policy covering a loss relating to the item (See Borghesi, Col.4, lines 20-67 to Col.5, lines 25; Col.17, lines 1-50).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as

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on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(K) As per claim 11, Borghesi discloses the method wherein a premium associated with the insurance policy is paid by a manufacturer of the item (Col.4, lines 20-67).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claims 1 and 10, and incorporated herein.

(L) As per claim 12, Borghesi discloses the method wherein the item is an automobile of a particular make and a model (Col.9, lines 57-67 to Col.10, line 28).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claims 1 and 10, and incorporated herein.

(M) As per claim 13, Borghesi discloses the method wherein the insurance policy covers comprehensive losses relating to the item (Col.10, lines 6-67).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claims 1 and 10, and incorporated herein.

(N) As per claim 14, Borghesi discloses the method wherein the insurance policy covers collision losses relating to the item (Col.9, lines 7-67 to Col.10, line 28).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claims 1 and 10, and incorporated herein.

(O) As per claim 15, Borghesi discloses the method wherein the insurance policy is provided without consideration of further characteristics of the buyer (Col.9, lines 7-67).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claim 1, and incorporated herein.

(P) As per claim 16, Borghesi discloses the method wherein the insurance policy covers all users of the item (Col.15, lines 24-67 to Col.16, line 67).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claims 1 and 10, and incorporated herein.

(Q) As per claim 17, Joao discloses the method wherein the insurance policy remains in effect if the buyer moves from the geographic region (Col.2, lines 19-49).

(R) As per claim 18, Joao discloses a method for providing an insurance policy relating to a sale or lease of an item (Col.1, lines 6-65). Joao does not explicitly disclose receiving an indication of an item sold to a buyer for which insurance is provided by a third party; charging a premium for the insurance policy to the third party, the premium based on a class of the item and a geographic region of the buyer without consideration of further qualifications of the buyer.

However, these features are known in the art, as evidenced by Borghesi. In particular, Borghesi suggests receiving an indication of an item sold to a buyer for which insurance is provided by a third party (Col.9,, lines 18-67 to Col.10, line 45); charging a premium for the

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insurance policy to the third party (Col.13, lines 12-67), the premium based on a class of the item and a geographic region of the buyer without consideration of further qualifications of the buyer (Col.9, lines 7-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(S) As per claim 19, Joao discloses a method for determining an insurance premium to be charged to a party providing insurance to a buyer of an item (Col.1, lines 6-67), comprising: calculating a premium to be charged for each insurance policy issued to purchasers or lessees in the geographic area (Col.2, lines 18-67). Joao does not explicitly disclose receiving, from a manufacturer, an indication of a class of items for which insurance is to be provided to a buyer of one of the class of items; receiving, from a manufacturer, an indication of a geographic region in which a buyer must reside to receive the insurance, the premium being based on the class of items and the geographic region, without consideration of further characteristics of the buyer.

However, these features are known in the art, as evidenced by Borghesi. In particular, Borghesi suggests receiving, from a manufacturer, an indication of a class of items for which insurance is to be provided to a buyer of one of the class of items (Col.4, lines 20-67); receiving, from a manufacturer, an indication of a geographic region in which a buyer must reside to

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receive the insurance (Col.4, lines 20-67, the premium being based on the class of items and the geographic region, without consideration of further characteristics of the buyer (Col.9, lines 7-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(T) As per claim 20, Joao discloses a method of receiving an insurance policy with a sale or lease of an item (Col.1, lines 6-67), comprising: completing a sales agreement for one of a purchase and a lease of an item (Col.2, lines 50-67 to Col.3, line 21). Joao does not explicitly disclose receiving a paid-up insurance policy for the item, the insurance policy being provided based on a class of the item and the geographic location in which the buyer resides.

However, this feature is known in the art, as evidenced by Borghesi. In particular, Borghesi suggests receiving a paid-up insurance policy for the item, the insurance policy being provided based on a class of the item and the geographic location in which the buyer resides (See Borghesi, Col.9, lines 8-67 to Col.10, line 28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle,

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premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches motor vehicle monitoring system for determining a cost of insurance (5,797,134), insurance verification sytem and method (6,233,563) and method and apparatus for internet on-line insurance policy service (US 2002/0116228).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


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V.F

March 9, 2003



DINH X. NGUYEN
PRIMARY EXAMINER